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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,187	11/25/2003	James J. Kinsella	ETC7455.055	1186
27060 7590 06/13/2007 ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (EATON) 136 S WISCONSIN ST PORT WASHINGTON, WI 53074			EXAMINER DEBERADINIS, ROBERT L	
			ART UNIT 2836	PAPER NUMBER
			MAIL DATE 06/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/707,187	Applicant(s) KINSELLA ET AL.	
	Examiner Robert DeBeradinis	Art Unit 2836	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-21 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6 and 10 is/are rejected.
- 7) ☒ Claim(s) 3,6-9 and 11-15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

The reply filed 3/29/07 consists of remarks related to rejection of claims.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Response to Arguments

The Applicant claims the Examiner has not set forth a comparison of any of the claims of the application and patent, nor has provided any reasons why one of ordinary skill in the art would conclude that the invention, as claimed, would be an obvious variation of any of the patented claims. The Examiner merely alleged that because claim 1 claims a contactor assembly with a controller it is not patentably distinct from the claim controller in the application. This is insufficient. The Examiner must compare claims and follow the directive set forth above. **Applicant believes the Examiner cannot show double patenting as the claims in this application refer to closing of contactors (claim 1); engaging contacts (claim 10); and transmitting "close" signals; whereas the claims of the 6,967,549 patent all generally refer to the opening of contacts. Comparing the claims clearly shows that there is no obviousness-type double patenting between the pending claims and USP 6,967,549.**

The Examiner made the obvious type double patent using no secondary reference thinking that there would be no question of obvious one of ordinary skill would have when comparing the contact dynamic conditions of a contactor between opening and closing the contacts of a contactor, both dynamic conditions result in generating an arc across the contacts, when the contacts are just separating on opening or when the contacts are just coming together on closing. It would have been obvious to one having ordinary skill in the art to use the same control system to switch

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the contactor (opening or closing contacts) when a minimum voltage exists between contacts to minimize the arcing.

In response to the Applicant's above arguments and remarks, that **the Examiner cannot show double patenting as the claims in this application refer to closing of contactors (claim 1); engaging contacts (claim 10); and transmitting "close" signals; whereas the claims of the 6,967,549 patent all generally refer to the opening of contacts. A new Double Patenting Rejection is made.**

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,2,4,6,10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,4,5,6,10 of U.S. Patent No. 6,967,549 in view of PENROD 4,152,634.

CLAIMS 1,2,4,6,10.

PATENT claims a number of contacts arranged to conduct current when in a closed position; a plurality of actuating assemblies, each in operable association with a set of contacts; and a controller connected to the plurality of actuating assemblies and configured to initially **open** only one set of contacts when an **open** condition is desired and then **open** a remaining set of contacts after the one set of contacts is **open**.

PATENT does not claim monitoring voltage in an electrical system having a power source and a load; **closing** at least a first contactor of a multi-contactor assembly configured to regulate power supplied to the load by the power source; and thereafter closing another contactor of the multi-contactor assembly at a prescribed moment following the **closing** of the first contactor.

PENROD discloses power contactor for controlling the application of power to and the character of current to a load includes a power relay having contacts connected between a source of power and a load. PENROD teaches the controller controlling the auxiliary contacts are designed to close just prior to either **closing or opening** of the main contacts and will open just after either the **closing or opening** of the main contacts to provide gating current to the solid state device thereby to reduce the

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potential across the main contact to prevent arcing during **opening or closing** (col.2, lines 1-11).

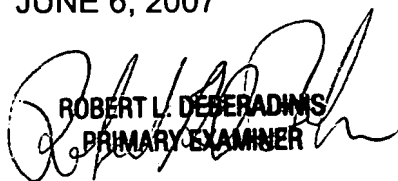
It would have been obvious to one having ordinary skill in the art at the time of this invention to have modified the controller and the method of controlling the contactor to close at the prescribed moment in time as well as open at the prescribed moment in time after a fault, to either disconnect power when a fault is detected or restore power after a fault is cleared, to prevent arcing between the contacts of a contactor.

Any inquiry concerning this communication should be directed to Robert L. DeBeradinis whose number is (571) 272-2049. The Examiner can normally be reached Monday-Friday from 8:30 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Brian Sircus, can be reached on (571) 272-2058. The Fax phone number for this Group is (571) 272-8300.

RLD

JUNE 6, 2007


ROBERT L. DEBERADINIS
PRIMARY EXAMINER